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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/139,386 08/25/98 MONFORTE

J GETR. 031-STA

022798 HM12/1116
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EXAMINER

TUNG, J

ART UNIT

PAPER NUMBER

1656

DATE MAILED:

11/16/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/139,386

Applicant(s)
Monforte et al.

Examiner
Joyce Tung

Group Art Unit
1656



☒ Responsive to communication(s) filed on Aug 29, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-87 is/are pending in the application.

Of the above, claim(s) 22-87 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-21 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-87 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 14

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1656

Response to Amendment

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1656.

1. Applicants' arguments, filed 8/29/2000, have been fully considered but they are not deemed to be persuasive. Rejections and /or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
2. Regarding the rejection of claims 1-9 and 11-21 under 35 U.S.C 103(a) over Koster in view of Richards et al., the response argues that Richards et al. do not teach the specific modification of a 3'-region of a primer to remove the primer prior to analysis. The response also argues that invention is clear that cleaving in the 3'-region of a primer to reduce the length of the nucleic acid prior to analysis and the combined references has no motivation. However, The example 17 (See column 31) teaches that incorporation of alpha-thiotriphosphate to generate primer extension products containing phosphorothioate linkages followed by treatment with 2-iodoethanol for cleavage (See column 32, lines 1-14). Thus, an ordinary skill in the art would have made a primer with cleavage site at 3' end by incorporating alpha-thiotriphosphate for a reasonable expectation of success based upon the teachings of Koster because the position of the cleavable site is based upon the needed. This is routine practice in the art at the time of the instant

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invention. Furthermore, the functional language "to reduce the length of the nucleic acid prior to analysis" does not have patentable weight. Regarding the motivation of combining these references, the method of Koster applies a modified primer for increasing mass spectrometric performance (See column 13, lines 3-35) and the method of Richards et al. to modify the amplified products is efficient and economy (See the Abstract). Thus, an ordinary skill in the art have combined these references for a reasonable expectation of success. Therefore, the rejection is maintained.

3. Claims 1-9 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koster (5,547,835) in view of Richards et al. (5,427,929).
4. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koster (5,547,835) in view of Richards et al. (5,427,929) and Wu et al. (Genomics 1989, Vol. 4, pg. 560-569).
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiries concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is (703) 305-7112. The examiner can normally be reached on Monday-Friday from 8:00 AM-4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached at (703) 308-1152.

Any inquiries of a general nature or relating to the status of this application should be directed to the Chemical/Matrix receptionist whose telephone number is (703) 308-0196.

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1656 via the PTO Fax Center located in Crystal Mall 1 using (703) 305-3014 or 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Joyce Tung

November 7, 2000


W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600